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Charles D. Powell

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES D. POWELL

Appeal 2008-0212
Application 10/696,906
Technology Center 3600

Decided: May 2, 2008

Before DONALD E. ADAMS, RICHARD M. LEBOVITZ, and
FRANCISCO PRATS, *Administrative Patent Judges*.

PRATS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to an apparatus for luring waterfowl. The Examiner has rejected the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

STATEMENT OF THE CASE

Claims 1-20 are pending and on appeal (App. Br. 3). Claim 1 is representative of the appealed subject matter and reads as follows:

1. An apparatus for luring waterfowl, the apparatus comprising:
a rotatable platform;

a force-generating unit for rotating the rotatable platform;
a power source for powering the force-generating unit to rotate the rotatable platform;
one or more support arms attached to the rotatable platform, each of said support arms including:
a lower end attached to the rotatable platform; and
an upper end positioned above the rotatable platform; and
a waterfowl decoy attached to the upper end of each support arm with said decoy being positioned above the rotatable platform;
wherein each decoy is moved along a substantially circular path above the rotatable platform as the rotatable platform is rotated by the force-generating unit, thereby providing a lure for waterfowl.

The Examiner applies the following documents in rejecting the claims:

Caccamo	US 3,768,192	Oct. 30, 1973
Sugimoto	US 5,956,880	Sep. 28, 1999
Porter	US 2003/0204983 A1	Nov. 6, 2003

The following rejections are before us for review:

Claims 1-7 and 15-17 stand rejected under 35 USC § 103(a) as being obvious over Caccamo in view of Sugimoto (Ans. 3).¹

Claims 1-7 and 15-17 stand rejected under 35 USC § 103(a) as being obvious over Sugimoto in view of Caccamo (Ans. 3).

Claims 8-14 and 18-20 stand rejected under 35 USC § 103(a) as being obvious over Caccamo as modified by Sugimoto further in view of Porter (Ans. 3).

¹ Examiner's Answer mailed April 21, 2006.

Claims 8-14 and 18-20 are rejected under 35 USC § 103(a) as being obvious over Sugimoto as modified by Caccamo further in view of Porter (Ans. 3).

OBVIOUSNESS -- CACCAMO AND SUGIMOTO

ISSUE

The Examiner makes two separate obviousness rejections of claims 1-7 and 15-17 over Caccamo and Sugimoto (*see* Ans. 3). Each rejection advances a distinct rationale. In the first rejection, the Examiner cites Caccamo as disclosing a decoy on a support arm, and Sugimoto as disclosing a decoy attached to a motor-driven rotatable platform (Final Rejection 2). The Examiner contends that a person of ordinary skill would have considered it obvious “to provide the decoy of Caccamo with a rotating platform, a force generating unit and a power source as shown by Sugimoto for the purpose of rotating the decoys in a circle to attract more waterfowl at times when wind and water power is not providing enough power” (*id.* at 2-3).

In the alternative ground of rejection, the Examiner contends that one of ordinary skill would have considered it obvious “to provide the decoy of Sugimoto with arms extending above the platform as shown by Caccamo for the purpose of using the device in locations where a top mount is not practical by mounting the rotatable platform and box from the bottom” (*id.* at 4).

Appellant contends that Caccamo’s device is a “simple, passive system that uses wind to animate a decoy for the purpose of luring waterfowl (unlike that claimed by Appellant),” whereas Sugimoto’s device “employs a complex, active system for the purpose of scaring fowl (also unlike that

claimed by Appellant)” (App. Br. 10). Appellant argues that “[t]here is no objectively reasonable basis to assert that the person of ordinary skill attempting to solve the myriad of problems associated with a waterfowl luring apparatus would combine only those elements selected by the Examiner from a passive waterfowl-luring device and an active bird-scaring device” to arrive at the claimed apparatus (*id.* at 11).

The issue with respect to these rejections, therefore, is whether the Examiner erred in concluding that one of ordinary skill would have considered claims 1-7 and 15-17 obvious in view of Caccamo and Sugimoto.

FINDINGS OF FACT

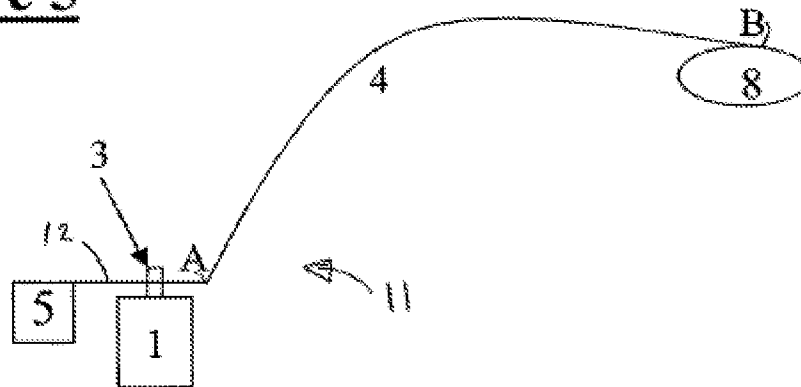
1. Claims 1 and 16 are the independent claims rejected as obvious over Caccamo and Sugimoto. Claim 1 recites an apparatus for luring waterfowl. The apparatus has a rotatable platform, a force-generating unit for rotating the rotatable platform, a power source for powering the force-generating unit, and one or more support arms attached to the rotatable platform. Each of the support arms has a lower end attached to the rotatable platform, and an upper end positioned above the rotatable platform.

Claim 1 requires a waterfowl decoy to be attached to the upper end of each support arm, with the decoy being positioned above the rotatable platform. The claim requires each decoy to move along a substantially circular path above the rotatable platform when the rotatable platform is rotated, thereby providing a lure for waterfowl.

Claim 16 recites a similar apparatus, but also requires each support arm to be flexible and to bend when attached to a decoy.

2. Appellant’s Figure 5, reproduced below, shows a side view of one embodiment of the claimed waterfowl-luring apparatus:

Figure 5

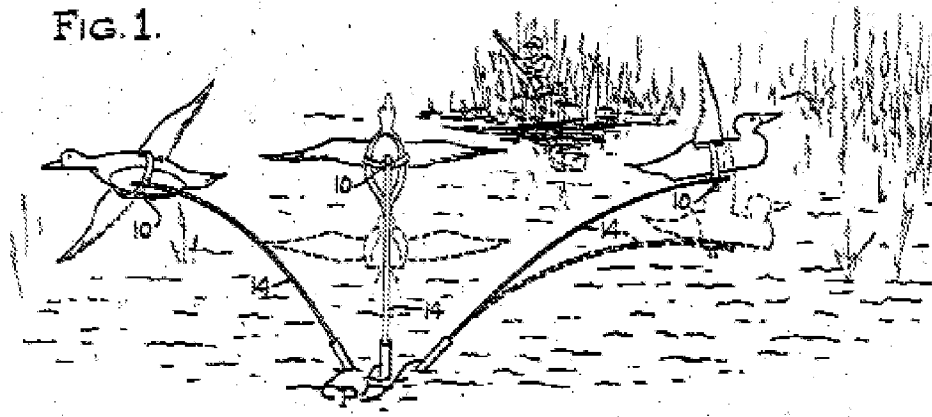


The figure shows support arm 4 “securely fastened to shaft 3 of the motor 1 by way of rotatable platform 12 with a decoy 8 attached to the upper end B of the arm 4” (Spec. 7). The Specification discloses that “[w]hen the motor 1 is engaged, the platform 12 is rotated and the support arm 4 turns and the decoy 8 resembles a bird in flight. A counterweight 5 is shown to give the system 11 balance when only one decoy 8 is used” (*id.*).

3. Caccamo discloses a device that “relates to waterfo[w]l and the like, decoys and more particularly to means for mounting such decoys in a manner to achieve animation thereof during use. Decoys as such are old and well known. The present invention is intended for use in combination with any type of decoys of ducks, geese and like fowl” (Caccamo, col. 1, ll. 11-17).

4. Figure 1 of Caccamo is reproduced below:

FIG. 1.



The figure shows “a panoramic view of a duck blind having decoys mounted in accordance with the present invention” (Caccamo, col. 2, ll. 10-12).

More specifically, the figure shows duck-shaped decoys with spread wings secured to the ends of long flexible arms 14 by the mountings 10, the opposite ends of the flexible arms being “adapted to [be] . . . anchored in earth or in a length of pipe P. The pipe P or end of the [arm] 14 is driven stake-like into the bottom of a pond adjacent a duck blind as illustrated” (*id.* at col. 2, ll. 58-64). Caccamo states that “[t]he arrangement is such that the decoy will bob up and down at the end of the flexible arm 14 as the latter flexes due to wind action against the spread wings” (*id.* at col. 2, ll. 64-67).

5. Caccamo discloses that one embodiment of the mounting apparatus 10 “facilitates rockability of the decoy D about the horizontal axis” as well as “rotary swinging of the decoy D about the vertical axis” (Caccamo, col. 3, ll. 44-50). Caccamo states:

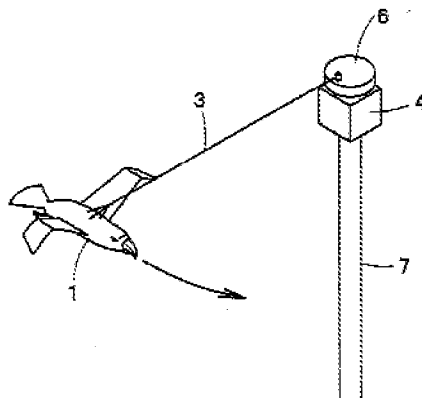
With the combined action afforded by the vertical and horizontal axis of the mounting means 10 the decoy D is enabled to achieve an animated action against and into the wind. This coupled with the up and down bobbing of the decoy at the end of the flexible arm 14 attains animation simulating the natural action of a bird over a pond adjacent a blind as illustrated in FIG. 1.

(*Id.* at col. 3, ll. 51-58.) Caccamo does not disclose moving its decoys in a rotating motion about the central anchored portion of the flexible arm.

6. Sugimoto discloses “an apparatus for preventing doves and crows and the like from accessing to buildings such as an aeroplane hangar or a large warehouse to preclude damage incurred by these kinds of birds” (Sugimoto, col. 1, ll. 4-7). Sugimoto’s apparatus “scares birds into flying away by flying a flying object having a predatory-bird-like figure. The flying object may [be] provided with a light emission unit, an ultrasonic sound transmitter, and a sound generator, alone or in combination to increase the scaring effect of the flying object against the birds” (*id.* at col. 1, ll. 32-37).

7. Figure 3 of Sugimoto, reproduced below, shows one embodiment of Sugimoto’s device:

Fig. 3



The figure shows the predatory bird-shaped flying object 1 attached to suspension wire 3, which is in turn is attached to “motor 5 and rotary body 6 [which] are mounted on the top end of the mast 7 to allow the flying object 1 to circularly fly” (Sugimoto, col. 3, ll. 53-55).

8. Sugimoto emphasizes that the bird-shaped “flying object 1 imitates features of predators such as eagles, hawks and falcons thought of as natural enemies of the dove and crow (hereinafter referred to as birds), namely mocks large wings 1*a*, sharply pointed beaks 1*b*, and claws 1*c*. . . . A stuffed bird of prey is sometimes used which naturally exhibits an excellent scaring effect” (Sugimoto, col. 2, ll. 26-34; *see also* Figure 1). Sugimoto also discloses that the “flying trajectory of the flying object 1 may simulate the flying behavior of an actual bird of prey by controlling in a regular pattern or randomly the rotational speed of the motor 5 and the reel-in rate pre unit time of the suspension wire 3 by the reel” (*id.* at col. 3, ll. 39-44).

9. Sugimoto states:

To scare the birds away more effectively, the flying object 1 may be provided with a light emission unit such as red light-emission diodes or bulbs at the locations corresponding to the eyes of the flying bird 1, and by continuously lighting or blinking them, scaring effect is further increased. The color of the light emission unit is not limited to red. Since the birds are generally known to avert variations in electromagnetic wave, it is useful to mount a relatively strong permanent magnet or an ultrasonic wave transmitter in the flying object 1. The scaring effect of the flying object 1 is further increased by housing in the flying object 1 a sound generator giving off a call of birds of prey.

(Sugimoto, col. 2, ll. 39-50).

PRINCIPLES OF LAW

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. “[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available

to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.”

In re Fritch, 972 F.2d 1260, 1265 (Fed. Cir. 1992) (citations omitted, bracketed material in original).

Recently addressing the issue of obviousness, the Supreme Court pointed out that the analysis under 35 U.S.C. § 103 “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). The Court advised that “[a] person of ordinary skill is . . . a person of ordinary creativity, not an automaton.” *Id.* at 1742.

The Court also advised, however, that “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does . . . because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.* at 1741. Thus, “[i]n determining whether obviousness is established by combining the teachings of the prior art, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *In re GPAC Inc.*, 57 F.3d 1573, 1581 (Fed. Cir. 1995) (internal quotations omitted).

During examination, the PTO must interpret terms in a claim using “the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into

account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

However, while claims under examination must be given their broadest reasonable interpretation, in *In re Buszard*, 504 F.3d 1364, 1367 (Fed. Cir. 2007), the Federal Circuit recently found it unreasonable to interpret a claim to encompass a prior art product where "a person of ordinary skill in the field" would have recognized that the two products were different, and where the specification and claims had "specifically state[d]" that the claims required a particular product. *Buszard*, 504 F.3d at 1367.

ANALYSIS

We agree with Appellant that the Examiner has not made out a prima facie case of obviousness based on Caccamo and Sugimoto. With respect to the Examiner's first obviousness rationale, we do not agree that a person of ordinary skill would have been prompted to provide Caccamo's apparatus with Sugimoto's motor-driven rotating platform "for the purpose of rotating the decoys in a circle to attract more waterfowl at times when wind and water power is not providing enough power" (Final Rejection 2-3).

We agree with the Examiner that Caccamo's device uses wind action to animate its decoys (*see* Finding of Fact ("FF") 4, above). However, the actual movements of Caccamo's decoys caused by the wind are a bobbing motion at the end of the flexible arm, a back-and-forth rocking motion about the horizontal axis enabled by the decoy's mounting device on the arm, and a pivoting motion about the vertical axis, also enabled by the decoy's mounting mechanism (*see* FF 4 and 5).

Thus, even assuming for argument's sake that it would have been desirable to provide Caccamo's device with a power source to supplement the wind, a person of ordinary skill would not have been prompted to add a power-driven rotatable platform to Caccamo's device because Caccamo simply does not suggest that moving the entire flexible arm and its attached decoy in the manner disclosed by Sugimoto (FF 7) would be desirable from a waterfowl-attracting standpoint. Because adding a power-driven rotatable platform to Caccamo's device would not enhance the desired bobbing, rocking, and pivoting motion of Caccamo's decoy, we do not agree that a person of ordinary skill would have been prompted to modify Caccamo in the manner proposed in the Examiner's first rejection.

In the second obviousness rejection over Caccamo and Sugimoto, the Examiner concludes that one of ordinary skill would have considered it obvious "to provide the decoy of Sugimoto with arms extending above the platform as shown by Caccamo for the purpose of using the device in locations where a top mount is not practical by mounting the rotatable platform and box from the bottom" (Final Rejection 4).

We do not agree that providing Sugimoto's decoy with Caccamo's flexible arms would result in the device recited in independent claims 1 and 16. Claims 1 and 16 both recite "[a]n apparatus for luring waterfowl." Both claims require the apparatus to have "a waterfowl decoy" that "provid[es] a lure for waterfowl" when the apparatus is set in motion.

While the Specification does not define "waterfowl," the Specification states that "[s]tatic decoys have been used for many years to attract wild game such as ducks and geese" (Spec. 2). Also, Caccamo discloses that its device "relates to waterfo[w]l and the like, decoys and more particularly to

means for mounting such decoys in a manner to achieve animation thereof during use. Decoys as such are old and well known. The present invention is intended for use in combination with any type of decoys of ducks, geese and like fowl” (FF 3 (Caccamo, col. 1, ll. 11-17)). We therefore interpret “waterfowl” as encompassing ducks, geese, and similar birds.

Caccamo discloses that movements suitable for luring waterfowl include a wind-aided bobbing motion at the end of the apparatus’ flexible arm, a back-and-forth rocking motion about the decoy’s horizontal axis enabled by the decoy’s mounting device, and a pivoting motion about the vertical axis (*see* FF 4 and 5).

Sugimoto discloses a device intended to scare birds such as doves and crows away from buildings (FF 6). Sugimoto discloses that its device scares doves and crows by mimicking predatory birds such as eagles, hawks, and falcons (FF 8 and 9). In contrast to Caccamo’s waterfowl-luring bobbing and rocking motions, Sugimoto discloses that its device mimics the flying trajectory of predators by flying in a circular pattern (*see* FF 7 and 8).

We recognize that claim terms must be given their broadest reasonable interpretation consistent with the prior art and the Specification. *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). However, given Caccamo’s disclosure that decoys with bobbing and rocking motions lure waterfowl, and the absence of any evidence that a circular motion would lure waterfowl, we do not agree with the Examiner that it is reasonable to interpret the claimed “waterfowl decoy” that “provid[es] a lure for waterfowl” to encompass Sugimoto’s bird-scaring device that moves in a circular pattern that emulates birds of prey. Thus, even assuming for argument’s sake that a person of ordinary skill would have been prompted to

use Caccamo's flexible arms to support Sugimoto's decoy, we do not agree with the Examiner that doing so would result in the claimed apparatus which would provide "a lure for waterfowl" when "moved along a substantially circular path."

In sum, we do not agree that either of the rationales advanced by the Examiner shows that the claimed apparatus would have been *prima facie* obvious to a person of ordinary skill viewing Caccamo and Sugimoto. We therefore agree with Appellants that the Examiner erred in concluding that one of ordinary skill would have considered claims 1-7 and 15-17 obvious in view of those references.

The Examiner argues that the motivation for making the claimed apparatus would have been "generally available to one of ordinary skill in the art" rather than explicitly stated in the references (Ans. 4). Specifically, the Examiner urges that a person of ordinary skill in the art would have known that it would be "obvious to use the concepts shown by Sugimoto to devi[s]e a waterfowl decoy to attract other waterfowl by employing a waterfowl decoy to replace the bird repelling decoy of Sugimoto with a waterfowl decoy as shown by Caccamo," and that a person of ordinary skill would have been "capable of varying the control parameters of Sugimoto to make the decoy fly in a waterfowl attracting pattern" (*id.*).

We are not persuaded by this argument. We recognize that, in addition to the references' specific teachings, the obviousness analysis must take into account the ordinary creativity and common sense of a person of ordinary skill in the art. *See KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741-42 (2007). However, we do not agree that a person of ordinary skill in the art, advised by Caccamo that the desired movement of a suspended

waterfowl-luring decoy was a bobbing and rocking motion, would have been induced to add a motor-driven rotatable platform to Caccamo's device by Sugimoto's disclosure of a bird-frightening device that mimic birds of prey.

Thus, because the Examiner has not made out a prima facie case of obviousness based on Caccamo and Sugimoto, we reverse both of the Examiner's obviousness rejections of claims 1-7 and 15-17 over those references.

OBVIOUSNESS -- CACCAMO, SUGIMOTO, AND PORTER
ISSUE

The Examiner makes two separate obviousness rejections of claims 8-14 and 18-20 over Caccamo, Sugimoto, and Porter (*see* Ans. 3). In the first rejection the Examiner cites Porter as disclosing a decoy mounted on a buoyant housing, and contends that "it would have been obvious to mount the decoy and housing of Caccamo as modified by Sugimoto on a buoyant housing as shown by Porter to use the unit in water too deep to sink a pipe into the ground" (Final Rejection 3).

In the alternative ground of rejection, the Examiner contends that "it would have been obvious to provide the decoy of Sugimoto as modified by Caccamo with a floating platform as shown by Porter for the purpose of using the decoys in water too deep to drive a pole into the bottom" (*id.* at 4-5).

The issue with respect to these rejections, therefore, is whether the Examiner erred in concluding that one of ordinary skill would have considered claims 8-14 and 18-20 obvious in view of Caccamo, Sugimoto, and Porter.

FINDINGS OF FACT

10. Claims 8-14 and 18 all ultimately depend from independent claims 1 and 16, and therefore recite apparatuses having the rotatable platform, force-generating unit, power source, and support arm(s) recited in claims 1 and 16. Claims 19 and 20 recite apparatuses similar to those of claims 1 and 16, including the rotatable platform, force-generating unit, power source, and support arm(s).

11. Porter discloses “a waterfowl decoy provided with a pair of wings mounted on an axle. The axle is biased against rotation in one direction, typically with surgical tubing or a spring” (Porter, [0019]; *see also* Figures 2A, 2B, 2C). Pulling a cord attached to the axle causes the wings to spin (*id.* at [0019]).

“The underside of the wings are preferably white while the top side of the wings are painted a dull color such a green or brown. As the wings spin, the white side flashes in a strobelike fashion, giving the appearance of a duck or goose flapping its wings” (*id.* at [0020]). Porter discloses that in “the preferred embodiment, the decoy is a floating decoy or is mounted to a floating frame” (*id.* at [0021]).

ANALYSIS

As discussed above, we agree with Appellant that the Examiner has not established a prima facie case that a person of ordinary skill viewing Caccamo and Sugimoto would have been prompted to add a motor-driven rotatable platform to Caccamo’s waterfowl decoy device. We see nothing in Porter’s disclosure of a buoyant decoy with spinning wings (FF 11) that remedies the shortcomings of Caccamo and Sugimoto. Because the Examiner has not shown that all of the elements in claims 8-14 and 18-20

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would have been obvious to a person of ordinary skill, we reverse both of the Examiner's obviousness rejections of those claims.

SUMMARY

We reverse both of the Examiner's obviousness rejections over Caccamo and Sugimoto. We also reverse both of the Examiner's obviousness rejections over Caccamo, Sugimoto, and Porter.

REVERSED

dm

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